

SN. 10/676,804

ATTORNEY DOCKET NO. CANO:091

REMARKS

Claims 1-14 remain pending in this application for which applicants seek reconsideration.

Amendment

Claims 1, 2, 5-9, and 12-14 have been amended to improve their form and to remove any informalities contained therein. Specifically, in claims 1, 2, 8, and 9, the extraneous term "images" appearing after "overlap" has been deleted. Claims 5-7 and 12-14 have been amended to depend only from either claim 2 or 9 to overcome the § 112 rejection.

All of the changes in the claims relate to removing informalities and correcting the dependency problem. None of the changes relate to narrowing the scope of the claims. No new matter has been introduced.

§ 112 Rejection

Claims 5/1, 6/1, 7/1, 12/8, 13/8, and 14/8 were rejected under 35 U.S.C. § 112, second paragraph, because they recite an element lacking antecedent basis. As these claims have been amended to depend only from claim 2 or 9, this rejection has been overcome.

Art Rejection

Claims 1-5 and 8-12 were rejected under 35 U.S.C. § 102(e) as anticipated by Motoyama (USPGP 2003/0194347), and claims 6, 7, 13, and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Motoyama in view of Ohki (USP 6,408,145). Applicants traverse these rejections because Motoyama is not prior art, and even if it were, it would not have disclosed or taught the claimed invention.

First, the priority application has a filing date of October 2, 2002, which predates the earliest effective filing date (April 10, 2003) of Motoyama. Applicants will shortly submit a certified English translation of the priority application to perfect priority.

Second, as to the § 103(a) rejection, applicants submit that Motoyama is not a viable prior art reference, even if applicants do not perfect priority. Specifically, § 103(c)(1) disqualifies the subject matter developed by another, which qualifies as "prior art" only under one or more of subsections 35 U.S.C. § 102(e), (f) and (g), against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1). Applicants submit that, at the time the invention was made, the subject matter disclosed in

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Motoyama and the claimed invention were owned by or subject to an obligation of assignment to the current assignee, namely Canon Kabushiki Kaisha. Accordingly, the § 103 rejection based on Motoyama should be withdrawn.

Third, even if Motoyama were deemed to qualify as prior art, applicants submit that it would not have anticipated claims 1-5 and 8-12 because it would not have disclosed forming an image in the first mode after the image formation in the second mode is completed. That is, the claimed invention provides first and second modes of image formation. In the second mode, at least one of a plurality of image forming units carries out the image formation. In the first mode, the plurality of image forming units carry out the image formation. The first mode is carried out after the second mode is completed. Applicants submit that Motoyama would not have disclosed this aspect of the invention, and Ohki would not have alleviated Motoyama's shortcomings.

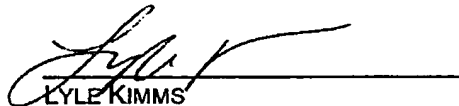
#### Conclusion

Applicants submit that claims 1-14 patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicants urge the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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12 OCTOBER 2005  
DATE

  
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REG. NO. 34,079 (RULE 34, WHERE APPLICABLE)

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